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In re application of  
Savvas Vasileiadis et al.  
Serial No. 09/525,176  
Filed: March 14, 2000

DECISION ON  
PETITION

For: PERMREACTOR AND SEPARATOR TYPE FUEL PROCESSORS FOR PRODUCTION  
OF HYDROGEN AND HYDROGEN, CARBON OXIDES MIXTURES

This is a decision on the PETITION UNDER 37 CFR 1.144 TO WITHDRAW THE RESTRICTION  
REQUIREMENT mailed October 3, 2002 and made final in the office action mailed January 9, 2003.

On October 2, 2002, a thirteen-way restriction requirement was made by the examiner. The examiner took the position that the groups were related as combination /subcombinations. Applicants traversed the restriction requirement in a response filed November 7, 2002. The examiner made the requirement final in an office action mailed January 9, 2003. An additional request to withdraw the requirement was made on March 26, 2003 by way of a telephonic interview.

On April 5, 2003, the instant petition under 37 CFR 1.144 was filed to formally request the withdrawal of the restriction requirement.

Applicant's position for the withdrawal of the restriction requirement is that the examiner has not shown that the separate groups are distinct.

## DECISION

Sections 803 and 806.05(c) of the MPEP state:

### 803 Restriction - When Proper

Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 806.04 - § 806.04(i)) or distinct (MPEP § 806.05 - §

### 806.05(c) Criteria of Distinctness for Combination, Subcombination, or Element of a Combination

In order to establish that combination and subcombination inventions are distinct, two-way distinctness must be demonstrated.

To support a requirement for restriction, both two-way distinctness and reasons for insisting on restriction are necessary, i.e., separate classification, status, or field of search.

See MPEP § 808.02.

The inventions are distinct if it can be shown that a combination as claimed:

(A) does not require the particulars of the subcombination as claimed for

patentability (to show novelty and unobviousness), and

(B) the subcombination can be shown to have utility either by itself or in other and different relations.

When these factors cannot be shown, such inventions are not distinct.

In the restriction requirement mailed on October 3, 2002, the examiner required restriction between 13 different groups. It is noted that the examiner failed to indicate which claims were covered by each of the groups listed. In the action, the examiner states that "the combination as claimed does not require all the particulars of the subcombination as claimed because each of the inventions set forth...is capable of supporting its own patent without requiring the inclusion of an additional non-elected invention." This reasoning is not persuasive. It is noted that all of the non-elected claims are dependent upon claims that were examined. Because these are dependent claims, said claims would have to contain all of the particulars of the subcombination based on the definition of dependent claims. All of the limitations in an independent claim are inherently part of any dependent claimed therefrom. The criteria listed above has not been met by the examiner, therefore, distinctness has not been shown.

Accordingly, the petition for withdrawal of the restriction requirement is **GRANTED**. The application is being forwarded to the examiner to rejoin all of the non-elected claims and preparing a new non-final office action addressing all pending claims.



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